

AMENDMENTS TO THE DRAWINGS

The attached replacement sheets of drawings includes changes to Figures 1 and 2 and are included in an appendix to this response. Both replacement sheets have been marked as “PRIOR ART,” no other changes have been made to the figures and no new material has been added. These sheets, which include Figures 1 and 2, replace the original sheets including Figures 1 and 2.

REMARKS/ARGUMENTS

The present Amendment and Response comprises Applicant's reply to the Examiner's non-final Office Action notification sent on April 15, 2009. Claims 1 and 3 are amended, and Claims 4 and 5 are cancelled. Accordingly, Claims 1-3 are now pending in view of the above amendments.

Applicant believes that no new matter has been added with regard to the claim amendments provided herein. Applicant does not donate or disclaim any claims or subject matter with the claim amendments made herein, and the Applicant expressly reserves the right to prosecute the original claims or any unclaimed subject matter in one or more future filed continuing applications.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, the Applicant requests that the Examiner carefully review any references discussed below to ensure that Applicant's understanding and discussion of the references, if any, is consistent with the Examiner's understanding. Also, Applicant's arguments related to each cited reference are not an admission that the cited references are, in fact, prior art.

I. Amended Drawings

The Examiner objected to Figures 1 and 2 on the grounds that the figures do not include a legend such as "Prior Art." Applicant submits new Figures 1 and 2, which are marked as "Prior

Art.” Enclosed is a marked-up version copy of Figures 1 and 2 showing this designation. No new matter has been added to Figures 1 and 2.

II. Rejection Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected Claims 3 and 5 under 35 U.S.C. § 112, Second Paragraph for indefiniteness on the grounds that they do not distinctly claim the subject matter which is regarded as the invention. The Examiner stated that, regarding Claim 3, the limitation “arranged at regular heights” renders the claim indefinite because it is unclear what the applicant is referring to when using the word “regular,” as this word can be interpreted to have many different meanings.

Applicant has amended Claim 3 to include a limitation of “arranged at predetermined heights.” Thus, Applicant respectfully requests that the rejection to Claim 3 be withdrawn.

Applicant has canceled Claim 5, thus this rejection is now moot.

III. PRIOR ART REJECTIONS

A. Rejection Under 35 U.S.C. § 102(b)

The Examiner rejected Claim 1, under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,389,266 (“Clum”). The Examiner asserts Clum discloses a cutoff device comprising a framed housing opened at a lower end and supporting a cover having a cutoff wall being opened at a lower end, and a flexible liquid bag attached to the lower end of the cutoff wall.

It is well recognized that claims are anticipated if, and only if, each and every element, as set forth in the claim is found in a single prior art reference. Vertegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown as a complete detail as contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989). See MPEP § 2131. To constitute anticipation, all material

elements of the claim must be found in one prior art source. In re Marshall, 198 U.S.P.Q. 344 (C.C.P.A. 1978). Additionally, the elements of the reference must be arranged as required by the claim. In re Bond, 15 U.S.P.Q. 2d 1566 (Fed. Cir. 1999). Applicant respectfully submits that the cited reference does not teach all the materials elements and do not arrange the elements as required by the rejected claim language.

Applicant asserts that Clum's invention teaches use of "a chamber 16 comprising a housing enclosed about **all but the bottom** so as to provide an open bottom chamber." (col. 3, ll. 58-60; emphasis added) Additionally, Clum discloses that his invention is a "skirt" and the bottom edge of the open-bottom skirt may be a "flexible boot" which may conform to the surface area to enclose the chamber. (col. 3, l. 66-col. 4, l. 2).

Unlike Clum, the present invention discloses a flexible liquid bag that is attached around the lower end of a cutoff wall and that such attachment is by means of a zipper as discloses in Claim 1. Additionally, the sealing of a skirt edge in Clum required attachment to a lower surface. Further, the present invention differs discloses a liquid and a heavy substance to be placed inside the flexible liquid bag to weigh the flexible liquid bag down thus creating a close seal with a desired underwater surface, rather than sealing a skirt edge to form an enclosed area as disclosed by Clum. As such, Applicant respectfully requests that the rejection to Claim 1 under 35 U.S.C. § 102(b) be withdrawn.

B. Rejection Under 35 U.S.C. § 103

The Examiner rejected Claims 2 and 3 under 35 U.S.C. § 103 as being unpatentable over Clum in view of U.S. Patent No. 3,967,458 ("Scales"). Regarding claim 2, the Examiner stated Scales teaches a housing of a marine apparatus comprising a telescopic column that is extendible

or compressible, an upper support frame coupled to an upper end of the telescopic column, and a lower support frame coupled to the lower end of the telescopic column. The Examiner stated it would have been obvious to combine Clum's cutoff device to include Scales' telescopic housing for better operation capabilities in a wide range of water depths.

With respect to claim 3, the Examiner stated Scales teaches an outer surface of a wall that is supported by a horizontal bar arranged at a regular height. The Examiner stated it would have been obvious to include Scales' horizontal support bar in Clum's cutoff device to provide lateral stability to the apparatus and further that it would have been obvious to use multiple horizontal support bars in the structure.

The U.S. Supreme Court, in KSR Int'l. Co. v. Teleflex Inc., 82 USPQ 2d 1385, 1391 (2007), reiterated the standard for determining obviousness under 35 U.S.C. § 103 as being the factual inquiries set forth in Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966). In Graham, the Court stated that obviousness is determined by first determining the scope and content of the prior art, then ascertaining the differences between the invention, as claimed, and the prior art, and then resolving the level of ordinary skill in the prior art. Against this background, the obviousness or non-obviousness of the claimed subject matter is determined. Secondary considerations may also be utilized in this analysis to give light to the circumstances surrounding the origin of the subject matter sought to be patented. KSR Int'l Co., 82 USPQ 2d at 1391. When making any obviousness rejection, the Examiner must first acquire a thorough understanding of the claimed invention by reading the specification and claims to understand what the Applicant is claiming as his invention. MPEP § 904.

To establish a prima facie case of obviousness under 35 U.S.C. §103(a), the Examiner must clearly articulate the reason(s) why the claimed invention would have been obvious (i.e.,

the analysis supporting the rejection must be made explicit.) See MPEP § 2142. “Rejections on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See MPEP § 2142; In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); see also KSR Int’l Co., 82 USPQ 2d at 1396. To support a 103(a) rejection, the examiner must demonstrate that a person of ordinary skill in the art would have had reason to attempt to make the claimed device, or carry out the claimed process, and would have had a reasonable expectation of success in doing so. See Noelle v. Lederman, 355 F.3d 1343, 1351–52 (Fed. Cir. 2004); Brown & Williamson Tobacco Co. v. Philip Morris, Inc., 229 F.3d 1120, 1121 (Fed. Cir. 2000); see also KSR Int’l Co., 82 USPQ2d at 1391.

In addition to the arguments set forth above with regard to the Examiner's rejection under 35 U.S.C. § 102(b), which Applicant incorporates herein in their entirety, Applicant respectfully requests that the Examiner withdraw the rejections for obviousness on the grounds that the cited references – either individually or in combination – fail to teach or suggest, or otherwise render obvious each and every element of the newly amended claims. As noted above, Clum (individually or in combination with Scales) does not teach the use of a flexible liquid bag attached by means of a zipper to the lower end of a cutoff wall nor does Clum teach using a heavy substance and a liquid to weigh down the flexible bag to create a close seal with an underwater surface.

With regard to Claims 2 and 3, the Applicant has amended Claim 1 as described above. Claims 2 and 3 are now in a condition for allowance given that neither Clum nor Scales, alone or in combination, disclose the claimed invention. Accordingly, the Examiner is respectfully requested to withdraw the 35 U.S.C. § 103(a) rejections of Claims 2 and 3.

The Examiner rejected Claims 4 and 5 as obvious over Clum in view of U.S. Patent No. 5,520,364 (“Bloxson”). Applicant has cancelled Claims 4 and 5 in an effort to expedite allowance of claims. However, Applicant does not acquiesce to the Examiner’s rejection of these claims. Applicant’s cancellation of Claims 4 and 5, thus make the Examiner’s rejection moot.

CONCLUSION

In view of the foregoing, Applicant believes the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner’s Amendment, the Examiner is requested to contact the undersigned attorney.

Applicant believes no fees are due for this submission. However, please credit any over payment or debit any under payment to Deposit Account No. 08-2665.

Respectfully submitted,

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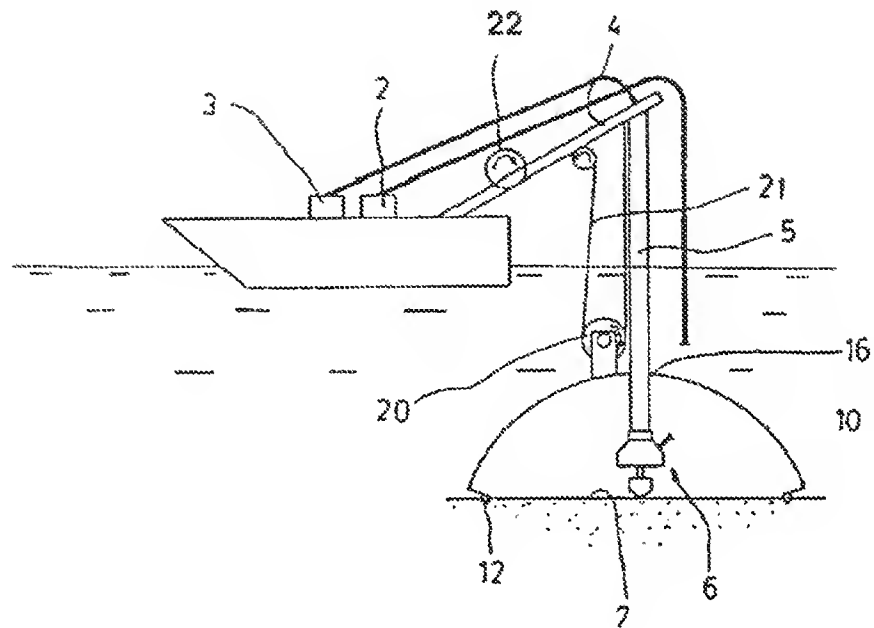
Dated: July 6, 2009

APPENDIX

MARKED-UP DRAWING SHEETS

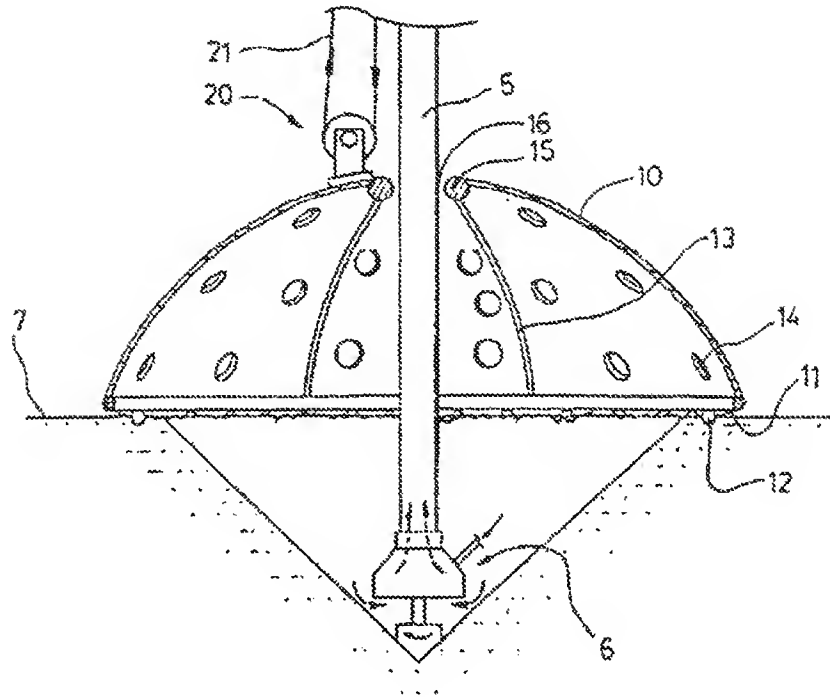
Prior Art

Fig.1



Prior Art

Fig. 2



REPLACEMENT DRAWING SHEETS